

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 09/602,412
Attorney Docket No.: A8492

REMARKS

Claims 1, 3-13, 15-25, and 27-40 are all the claims pending in the application. By this Amendment, Applicant amends independent claims 1, 13, and 25 to further clarify the invention and dependent claims 4, 16, and 28 for conformity therewith.

Summary of the Office Action

The Examiner considered Applicant's arguments and request for reconsideration filed on October 23, 2006, but deemed them moot in view of new grounds the Examiner found for rejecting the claims. Claims 1, 3-13, 15-25, and 27-40 stand rejected under 35 U.S.C. § 103(a).

Claim Rejections

Claims 1, 3-13, 15-25, and 27-40 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,298,373 to Burns et al. (hereinafter "Burns") in view of U.S. Patent No. 7,100,106 to Ramaley et al. (hereinafter "Ramaley").

Of the rejected claims, only claims 1, 13, and 25 are independent. The independent claims are directed to methods for responding to a request for a web page, corresponding apparatus claims of method claims for responding to a request for a web page, and corresponding article of manufacture claims of method claims for responding to a request for a web page.

As amended, Applicant respectfully submits that the claims are not unpatentable under 35 U.S.C. § 103(a) over Burns in view of Ramaley.

Burns is not Analogous Prior Art

Burns addresses the problem of latency and slow delivery of data from content providers' servers to an Internet Service Provider's (ISP's) machines, as the data is en route to clients that have requested it (Burns, col. 1, line 50 – col. 2, line 3; col. 2., line 58 – col. 3, line 32; col. 3,

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lines 41-57). The disclosure of Burns is directed to the caching of web pages and data on a machine or machines located at an ISP which is situated between clients that request and view web pages and content providers' servers that supply the web pages and data in response to requests from the clients (col. 4, lines 32-44; col. 4, lines 49-59).

Applicant respectfully submits that the Burns reference is not reasonably pertinent to the problem of reducing the expense required to respond to a request for a web page. A person having ordinary skill in the art would not reasonably have expected to solve the problem of reducing the expense required to respond to a request for a web page by considering a reference dealing with addressing the problem of slow data transfer between content providers' servers and an ISP's servers.

The differences in function between the disclosure of Burns and Applicant's disclosure are significant and prevent Burns from being classified as analogous prior art.

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992).

Because the disclosure of Burns is neither in the field of Applicant's endeavor nor reasonably pertinent to the particular problem with which Applicant is concerned, Applicant respectfully submits that Burns cannot be relied on as a reference under 35 U.S.C. § 103.

Not All Limitations are Taught or Suggested by Combination

Though Applicant submits that relying on Burns under 35 U.S.C. § 103 is improper because Burns does not constitute analogous prior art, even if Burns and Ramaley are combined,

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not all claimed limitations are taught or suggested by the combination. For example, among other limitations that are not taught or suggested by the combination, Burns in view of Ramaley does not teach or suggest “determining whether to respond to a request for a web page by retrieving the web page from a cache or by constructing the web page” as disclosed in claim 1, or the corresponding limitations disclosed in claims 13 and 25.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). Applicant respectfully submits that, because not all claim limitations of independent claims 1, 13, and 25 are taught or suggested by Burns in view of Ramaley, the claims are patentable. Applicant also submits that dependent claims 3-12, 15-24, and 27-40 are patentable at least by virtue of their dependency on independent claims 1, 13, and 25.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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